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REMARKSSURRENDER OF ORIGINAL PATENT

Applicant will surrender the original copy of United States Patent No. 5,897,307 upon its location and/or Applicant will  
5 provide an affidavit or declaration as to loss or inaccessibility of the original patent. Applicant offers to surrender the '307 patent in accord with 37 CFR § 1.178.

ERROR IN ORIGINAL PATENT

10 The Examiner has stated that Applicant's reissue oath/declaration filed with this application is defective "because it fails to identify at least one error which is relied upon to support the reissue application." However, this is incorrect. In Applicant's request for reissue examination of the  
15 patent in the document titled "Preliminary Amendment with Remarks Pursuant to 37 CFR § 1.173(c)," Applicant clearly states the following:

"The applicant brings this reissue application by reason to correct errors without any deceptive intent  
20 and by reason to that the patentee claimed less than to which he had a right, pursuant to 35 U.S.C. § 251."

This statement explains that the former attorney of record on behalf of the applicant failed to appreciate the full scope of the invention. An attorney's failure to appreciate the full  
25 scope of the invention qualifies as an error under section 251 and is correctable by reissue. See Mentor Corporation v.

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AMENDMENT AND RESPONSE TO OFFICE ACTION MAILED 03/8/2002  
S/N 09/844,564 (filed: 04/27/2001)  
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Coloplast, Inc., 998 F.2d 992, 995, 27 U.S.P.Q.2d 1521

(Fed.Cir.1993) (The Federal Circuit found that reissue "error" is generally liberally construed, and has recognized that "[a]n attorney's failure to appreciate the full scope of the invention"

5 is not an uncommon defect in claiming an invention), see also, In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed.Cir.1984), cert. denied, 469 U.S. 1209, 105 S.Ct. 1173, 84 L.Ed.2d 323

(1985). Herein, Applicant believes that the original attorney had included in the claims extraneous limitations that were

10 unnecessary within the scope of the invention and thereby failed to appreciate the full scope of the invention.

The United States Patent law allows for broadening reissue when the application for reissue was applied for within two years of the patent's date of issue. As § 251 states, "No reissued

15 patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." 35 U.S.C. § 251. Applicant's US

Patent No. 5,897,307 issued on April 27, 1999. Applicant filed its request for reissue examination on April 27, 2001. As this

20 requested reissue examination was filed within the time limits established in 35 U.S.C. § 251, a broadening reissue is

acceptable. See Switzer v. Sockman, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (The CCPA found that a reissue filed on the 2-year anniversary date is considered as filed within 2 years).

25 Therefore, Applicant has met the requirements of sufficient grounds in order to seek a reissue of the '307 Patent under 35

U.S.C. § 251.

**REJECTION OF AMENDED CLAIMS IN REISSUE APPLICATION**

The Examiner has rejected Claims 1-16 under the argument that Applicant is not entitled to a broadening reissue because it appears that Applicant is improperly trying to recapture "subject matter surrendered in the application for the patent upon which the present reissue is based." Applicant disagrees with examiner's evaluation of the file history and submits that there was no surrender of subject matter and there were no claim amendments in the original application with respect to the originally allowed Claims 3-6, 9-12 and 15-18. Applicant further submits the following arguments in support of Applicant's reissue application to be examined.

15      **A. THE RECAPTURE RULE**

The "Recapture Rule" states that "A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent." MPEP § 1412.02 citing Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 45 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), et. al. In re Clement sets forth a two part test giving guidance in the determination of whether recapture is inappropriate:

25      The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under

5 Mentor [Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)], courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

10 The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

In re Clement, 131 F.3d at 1468-69, 45 USPQ2d at 1164.

20 The Examiner has applied the first part of the Clement test and identified the ways in which the Examiner believes Applicant's reissue claims are broader than the '307 Patent claims. The Examiner has focused on Applicant's Preliminary Amendments to Claims 1 and 10 and new Claim 13. The amendments to Claim 1, deleting following: "integrally formed", "glossy" and  
25 "a width equal", has been identified as broadening amendments. The Examiner has argued that in Claim 10, the elimination of the word "glossy" is broadening. Finally, in Claim 13, a new claim, the lack of a reference to "integrally formed", "glossy" and "a width equal" is seen as broadening by the Examiner.

30 In applying the second step of the Clement test, Applicant will show that there was no surrender of subject matter with respect to these amendments. The second step requires that the Applicant "surrendered particular subject matter." Applicant had not surrendered any subject matter, with in the context of  
35 Clement and Hester Industries. A surrender of subject matter may

be made in several ways. The MPEP § 1412.02 lists the following ways that matter may have been surrendered: 1) the omitted limitation was originally argued in the original application to make the application claims allowable over a rejection or  
5 objection made in the application; 2) a limitation was added to obviate a rejection; 3) the Examiners reasons for allowance specifically stated that the original application was allowed based on the limitation to be deleted. See MPEP § 1412.02. Based on the foregoing categories to establish improper recapture in  
10 broadening a reissue application, none of these three circumstances exist here.

**B APPLICANT PRESENTED NO ARGUMENTS TO OVERCOME CLAIM  
OBJECTIONS OR REJECTIONS**

15 When Applicant amended the objected claims to put them in condition for issuance, Applicant made no limiting amendments, nor did Applicant make any arguments in support of the claim amendments. In Applicant's response dated November 3, 1998, applicant merely resubmits Claim 3 and Claim 6 as independent  
20 claims, in the allowable form. Specifically, prior to the claim amendments, Applicant stated, "Please cancel claims of record 1 to 18 without prejudice or disclaimer and replace with the newly drafted claims as follows." See Applicant's Correspondence dated November 3, 1998, titled "AMENDMENT A." The newly drafted  
25 claims 19 through 30 included independent Claims 19 and 28 that eventually became issued claims 1 and 10. These two independent

claims are original dependent Claims 3 and 6, in independent form.

There were no claim amendments to overcome a rejection;

Applicant's action was merely putting the claims in proper form to resolve an objection. Therefore, Applicant has made no

5 limiting arguments that could be construed as to surrendering subject matter or an attempt at limiting the scope of the claim language. There are no such arguments, merely a statement of what steps Applicant had taken at the time to present his claims in a format for issuance. As there is no statements limiting the  
10 claims or arguing around any prior art, Applicant's Reissue Application can not be denied because Applicant has not surrendered any subject matter through argument.

**C. NO AMENDMENTS FOR ALLOWABILITY OF ALLOWED CLAIMS**

15 In the October 7, 1998 office action in patent application serial number 08/881,848, the application that eventually issued into the '307 Patent, the Disposition of Claims Section of the clearly states that Claims 3-6, 9-12 and 15-18 are only objected to. Then, at Section 4, the Examiner then states that "Claims 3-  
20 6, 9-12 and 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." This clearly states that these claims are allowable except as to form. See MPEP § 706.01  
25 ("If the form of the claim (as distinguished from its substance) is improper, an "objection" is made"). This means that these

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claims, while not able to be issued in their original form, were allowable if put into a form that was acceptable. Applicant did this by amending the dependent claims to read as independent claims.

5        Claim 1 in the issued '307 Patent was original Claim 3 in the 08/881,848 application. There was no actual amendment with regard to Claim 3 and there was no surrender of subject matter with regard to the content of Claim 3. If Claim 3 has been submitted in independent form, Claim 3 and all dependent claims  
10 would have been allowed. Similarly, there were no claim amendments with regard to original dependent Claim 6 from the 08/881,848 application. Application Claim 6 corresponds to '307 Patent Claim 10. If Applicant had submitted Claim 6 as an independent claim, it would have also been allowable. Therefore,  
15 there are no amendments made that would constitute a limitation upon the original Claims 3 and 6. Applicant's canceling of the original objected-to claims and rewriting them in a form that is acceptable within the rules of practice is not an action that would trigger the "Recapture Rule." There were no elements  
20 changed that led to the claims' allowability.

Applicant did not make a limiting amendment to original claims 3 and 6, Applicant merely put them into an condition that would make them allowable. If it can be construed that the correction of the claim's form that embodied an objection is  
25 amendment, the amendment most certainly does not give rise to a statement that the scope claims 1 and 2 were not in themselves

patentable. Claims 3 and 6 were only put into a form that was acceptable to lead to the issuance of the '307 Patent. A finding of an amendment limiting the scope of the claims based on putting claims 3 and 6 in independent form is improper. Clearly, it is  
5 permissible to amend Claims 1 and 10 of the '307 Patent in a broadening reissue application.

**D. NO STATEMENTS BY EXAMINER HAVING LIMITING IMPACT ON  
ALLOWED CLAIMS**

10 While it is true that Examiner had rejected Claims 1-2, 7-8 and 13-14 under a 35 U.S.C. § 103(a) Obviousness type rejection, these rejections have no bearing on the allowed claims. Examiner's comments only state very broadly and generally that Claim 1 would have been anticipated by Zellweger in light of Jon.  
15 The Examiner stated that "Zellweger discloses the invention substantially as claimed. However, Zellweger does not disclose a top wall defining a cutout right above the gas nozzle." The Examiner goes on to say that "Jon teaches the use of a U-Shaped wind shield ... having a top wall defining a cutout right above a  
20 gas nozzle for the purpose of allowing an ignited flame burning the fuel gas emitted from the gas nozzle to extend upwardly therethrough." However, this objection does not speak to the invention of the '307 Patent, nor does it address the claim language of the rejected claims originally filed in the  
25 08/881,848 Application. This rejection merely discusses aspects of the prior art, failing to take into account the inventive



nature of claims 1 and 2 in the original 08/881,848 Application. Applicant most certainly believes that Claims 1 and 2 would have been allowable had arguments been made to overcome the 103(a) rejection. Nonetheless, there was no statement in the claim  
5 rejections that would indicate what subject matter of the dependent claims was essential for allowance.

Most importantly, Examiner had offered no affirmative statement or given an explanation as to why Claims 3-6, 9-12, and 15-18 were allowable over the prior art. The only evidence  
10 offered by the file history is that the examiner believed that claims 1-2, 7-8 and 13-14 by themselves did not rise to the level of sufficient invention in light of Zellweger and Jon. Applicant made no arguments for or against this determination. This  
determination of allowability does not ascribe any statements  
15 against the allowable claims with regard as to what specific elements were uniquely inventive or allowable. Because of a lack of any tangible explanation as to which specific elements were required or essential for allowance, the Recapture Rule does not apply here. See Seattle Box Co. v. Industrial Crating & Packing,  
20 Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed.Cir.1984) (The Federal Circuit held "The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable"); See also In re Petrow, 402 F.2d 485,  
25 488, 159 USPQ 449, 451 (CCPA 1968); Ball Corp. v. United States, 729 F.2d 1429 (Fed.Cir.1984). There is no evidence or guidance

that any specific one element of the original Claims 3 and 6 was required to overcome the obviousness rejection in claims 1-2, 7-8 and 13-14. In light of no statements or evidence that would be an admission of limitation, Applicant must be allowed to engage  
5 in this broadening reissue application.

As shown by the arguments above, applicant must not be barred from broadening the scope of the claims in this reissue. Applicant presented no arguments to overcome the any prior art in the 08/881,848 Application. Applicant made no claim amendments  
10 to limit the scope of the allowed claims. Finally, the Examiner made no statements limiting the scope of the allowed claims to specific elements, nor did Examiner make any determination that specific elements of were determinative factors as to the patentability of the allowed claims. Therefore, Applicant's  
15 Broadening Reissue Application must be permitted for examination.

#### **EXAMINER'S REISSUE APPLICATION CLAIM REJECTIONS**

##### **A. REJECTION OF REISSUE APPLICATION CLAIM ONE**

The Examiner's action in the present Reissue Application  
20 reviews each proposed claim amendment and identifies matter that the Examiner believes the deletion of which would improperly broaden the claims and engage in recapture. In Claim 1, the examiner cites the deletion of the elements: "integrally formed;" "glossy;" and "a width equal." Examiner states that these are  
25 considered to be essential elements of the allowed claim. However, there is no basis for this determination. There was no

surrender in the original Claim 3 which later became Claim 1. These claims were allowed and merely objected to as to form. In the absence of any statements limiting surrendering any matter, the recapture rule does not apply. Seattle Box Co. v. Industrial  
5 Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed.Cir.1984) (The Federal Circuit held "The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable"); See also In re  
10 Petrow, 402 F.2d 485, 488, 159 USPQ 449, 451 (CCPA 1968); Ball Corp. v. United States, 729 F.2d 1429 (Fed.Cir.1984). There is no evidence in the file history as to whether any of these elements is specifically required to overcome the prior art. In the absence of any limiting statements, Applicant should not be  
15 prevented from seeking a broadening reissue and amending Claim 1 to delete these unnecessary limitations.

**B. REJECTION OF REISSUE APPLICATION CLAIM TEN**

Applicant's claim amendment in Claim 10 seeks to remove the  
20 word "glossy." The Examiner objects to Applicant's Preliminary Amendment to seek removal of the word "glossy." Examiner states that the word "glossy" is considered to be an essential element of the allowed claim. However, there is no basis for this determination. Claim 6 of the 08/881,848 application eventually  
25 became claim 10 of the issued '307 Patent. There was no surrender in the original Claim 6. This claim was allowed and

merely objected to as to form. In the absence of any statements limiting subject matter or arguments by applicant surrendering subject matter, the recapture rule does not apply. See Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed.Cir.1984) (The Federal Circuit held "The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable"); See also In re Petrow, 402 F.2d 485, 488, 159 USPQ 449, 451 (CCPA 1968); Ball Corp. v. United States, 729 F.2d 1429 (Fed.Cir.1984). There is no evidence in the file history as to whether this element is specifically required to overcome the prior art. In the absence of any limiting statements, Applicant should not be prevented from seeking a broadening reissue by this amendment to Claim 10.

**C. REJECTION OF REISSUE APPLICATION CLAIM THIRTEEN**

In new Claim 13, the Examiner objects to Applicant's new claims for omitting the alleged required claim limitations: "integrally formed;" "glossy;" and "a width equal." Examiner states that these are considered to be essential elements of the allowed Claim 3. However, there is no basis for this determination. There was no surrender in the original the 08/881,848 Application Claims 3 and 6. These claims were allowed and merely objected to as to form. In the absence of any statements limiting surrendering any subject matter, the

Recapture Rule does not apply. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed.Cir.1984) (The Federal Circuit held "The recapture rule does not apply where there is no evidence that amendment of the

5 originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable"); See also In re Petrow, 402 F.2d 485, 488, 159 USPQ 449, 451 (CCPA 1968); Ball Corp. v. United States, 729 F.2d 1429 (Fed.Cir.1984). There is no evidence in the file history as to whether any of these

10 elements is specifically required to overcome the prior art. In the absence of any limiting statements, Applicant should not be prevented from seeking a broadening reissue.

Applicant has shown that there is no evidence supporting the Examiner's Rejection of Applicant's Claim Amendments in the

15 Reissue Application. Applicant did not amend original the 08/881,848 Application Claims 3 and 6, which later became Claims 1 and 10 of the '307 Patent. These claims were allowed in the initial examination and there is no supporting file history evidence that would limit the scope of these claims. Therefore,

20 the claim amendments should not be rejected.

Similar to amendments in Claims 1 and 10, Claim 13 should not be rejected because it does not include limitations "integrally formed," "glossy" and "a width equal". There is no indication from the file history records as to require these

25 elements, therefore they are not required within the scope of the Applicant's reissue application.

**CONCLUSION**

Applicant has requested that Claim 1 and 13 be amended to remove the extraneous word "to" at line 21 of each claim.

Applicant has amended the word "said" in Claim 13, line 32 with  
5 the word "a" thereby overcoming the 35 U.S.C. § 112 antecedent basis rejection. Applicant has cancelled claim 16 without prejudice or disclaimer.

Applicant has presented arguments showing that Applicant did not amend the claims 3 and 6 of the original application, merely  
10 put the dependent claims in independent form. Applicant has also shown that Applicant presented no arguments that limited the scope of Claims 3 and 6, and to the contrary affirmatively expressed Applicant was not disclaiming any matter of the Application. Finally, the Examiner did not include any  
15 information that indicated his reliance upon the specific elements that applicant seeks to eliminate through the reissue application. Thereby, Applicant has shown that Applicant is not barred by the Recapture Rule because the Recapture Rule does not apply to Applicant's requested Reissue Application. Since, the  
20 Recapture Rule does not apply, Applicant's basis for error in the original '307 Patent, Applicant's original attorney's failure to appreciate the full scope of the invention, is valid error.

Through these arguments and amendments, Applicant has successfully traversed Examiner's rejection. Applicant  
25 respectfully requests that the Examiner initiate examination of Applicant's Reissue Application. Applicant is one month beyond

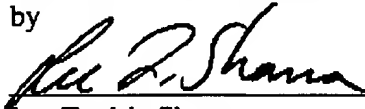
the shortened statutory time period and is a small entity. An extension of 1 month is requested. Please withdraw the amount of \$55.00 for extension of 1 month for a small entity, from the Trojan Law Offices Deposit Account No. 50-0703.

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Respectfully Submitted,

TROJAN LAW OFFICES

by



Lee Fredric Sharra

Reg. No. 43,108

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